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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/009,229

Applicant(s)

HIRATA, CHISATO *CH*

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 10-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 10-12 are directed to a method of forming a filled shaped PET fluid container, which is classified in class 53, subclass 440.

2. The product in claims 1-9 and the process in claims 10-12 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed does not require the process of changing the temperature. Furthermore, the process as claimed can be used with other products such as bag-type or paper containers.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 01/22/03 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the particular design as shown in the proposed drawing.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the human shape in claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not teach the decompression panels being planar sections. This is a new matter rejection.

***Claim Rejections - 35 USC § 102/103***

6. Claims 1, 4, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaillencourt et al. (5341946). Vaillencourt teaches the container being made from PET, an ornamental portion at 14, and the base portion is provided with pressure-responsive panels.

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Regarding claim 4, note portions 45 are substantially planar.

Regarding claim 5, note the arcuate portions at 41 conforming to the curvature of the bottle.

7. Claims 2, 3, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Vaillencourt rejection as set forth above, and further in view of JP 952570. Vaillencourt meets all claimed limitations except for the ornamental portion having an animal or a human shape and cap having a hat shape. JP'570 teaches that it is known in the art to provide a cap in the form of a hat shape and the bottle having a human shape. It would have been obvious to one of ordinary skill in the art to provide the ornamental portion having an animal or a human shape and cap having a hat shape in Vaillencourt as taught by JP'570 to attract customers.

With respect to the ornamental figurine, matter relating to ornamentation and has no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

8. Claims 1, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ota et al. (5407086). Ota teaches the container being made from PET (col. 1, line 49), a cap (col. 4, line 9). Portion 4 is the ornamental portion, and the base portion is provided with pressure-responsive panels 12.

Regarding claim 4, note portions 14 are substantially planar.

Regarding claim 6, note the rectangular decompression panels in Fig. 11.

9. Claims 2, 3, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota in view of JP 952570. Ota meets all claimed limitations except for the ornamental portion having an animal or a human shape and cap having a hat shape. JP'570 teaches that it is known

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in the art to provide a cap in the form of a hat shape and the bottle having a human shape. It would have been obvious to one of ordinary skill in the art to provide the ornamental portion having an animal or a human shape and cap having a hat shape in Ota as taught by JP'570 to attract customers.

With respect to the ornamental figurine, matter relating to ornamentation and has no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Carew et al. (6044996). Ota meets all claimed limitations except for the arcuate portion.

Carew teaches that it is known in the art to provide arcuate portions 11 as shown in Figs. 2 and 5, respectively. It would have been obvious to one of ordinary skill in the art to provide arcuate portions in Ota as taught by Collette to provide alternative pressure responsive panels.

11. Claims 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnakumar et al. (D426460) in view of Ota. Krishnakumar teaches an ornamental portion, and decompression panels. Krishnakumar '460 meets all claimed limitations except for the container being made from PET. Ota teaches that it is known in the art to make a container from PET. It would have been obvious to one of ordinary skill in the art to make a container from PET in Krishnakumar as taught by Ota to provide the desired material for the container.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnakumar et al. (D426460) in view of Carew et al. (6044996). Krishnakumar '460 meets all claimed limitations except for the arcuate portion. Carew teaches that it is known in the art to provide arcuate portions 11 as shown in Fig. 2. It would have been obvious to one of ordinary skill in the

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art to provide arcuate portions in Krishnakumar '460 as taught Carew to provide alternative pressure responsive panels.

13. Claims 2, 3, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Krishnakumar '460 rejections as set forth above, and further in view of JP 952570.

Krishnakumar '460 combination meets all claimed limitations except for the ornamental portion having an animal or a human shape and cap having a hat shape. JP'570 teaches that it is known in the art to provide a cap in the form of a hat shape and the bottle having a human shape. It would have been obvious to one of ordinary skill in the art to provide the ornamental portion having an animal or a human shape and cap having a hat shape in Krishnakumar '460 as taught by JP'570 to attract customers.

With respect to the ornamental figurine, matter relating to ornamentation and has no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

#### ***Response to Arguments***

14. Applicant's arguments, filed 01/22/03 with respect to the claims have been fully considered and are persuasive.

Applicant asserts that the Ota does not show an ornamental portion and the illustrated ornamental portion includes such features such as limbs and a head. Please note that this limitation is not included in claim 1. Claim 1 recites broadly an "ornamental portion" and portion 4 is an ornamental portion as claimed.

Furthermore, applicant asserts that Ota fail to teach decompression panels. On the contrary, Ota clearly teaches decompression panels. There is a multitude of data shown by the

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Ota reference that clearly teaches the panels provide added strength against deformation, e.g. col. 10, line 39).

With respect to the ornamental figurine, as set forth above, matter relating to ornamentation and has no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the



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organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai  
Examiner  
Art Unit 3727



April 6, 2003